

Application No. 10/749,761  
Response dated May 20, 2005  
Reply to Office Action of February 22, 2005

**REMARKS**

Claims 1 – 46 are presented for Examiner Chapman's consideration.

Pursuant to 37 C.F.R. § 1.111, reconsideration of the present application in view of the following remarks is respectfully requested.

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### **Response to Rejections**

By way of the Office Action mailed February 22, 2005, claims 1, 2, 3, 5, 7, 9 – 13, 15, 16, 21, 24, 26 – 28, 30 – 32, 35, 37, 39, 41 – 43, 45, and 46 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*). This rejection is respectfully traversed to the extent that it may apply to the claims as filed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 referencing *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990); *see also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Also, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” M.P.E.P. § 2131 (citing *Richardson*, 868 F.2d at 1236 (Fed. Cir. 1989)).

*Allen* does not anticipate each an every element of Applicants’ claims 1, 16, 17 and 31. Claims 1, 16, 17 and 31 require that “the elastic inner layer includes a front piece, a back piece and a crotch piece....”

The Examiner states that “Allen discloses ... a liquid permeable elastic inner layer (12) having ... a front piece (42) and a back piece (44) which are elastic in the lateral direction (col. 7, lines 7-11, *see also* col. 6, lines 65-66) and a crotch piece (46) which is elastic in the longitudinal direction 50) (col. 4, lines 19-24)... .” (Office Action at page 2, emphasis added).

Applicants respectfully disagree. The elements 42, 44 and 46 of *Allen* are “portions” of the diaper, NOT “pieces” of the topsheet. Therefore, *Allen* does not teach an elastic inner layer having a front piece, back piece and crotch piece as claimed by Applicants.

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Additionally, the Examiner fails to address the claim limitation, "wherein the crotch piece is attached to the front piece and the back piece...." *Allen* does not teach a non-continuous inner layer that is constructed of pieces attached together as claimed by Applicants.

Because *Allen* fails to teach each and every element of Applicants' claims 1, 16, 17 and 31, this rejection should be withdrawn.

Likewise, claims 2, 3, 5, 7, 9 – 13, 15, 21, 24, 26 – 28, 30, 32, 35, 37, 39, 41 – 43, 45, and 46 depend from claims 1, 17, or 31 and are patentably distinct over *Allen* for at least the same reasons as discussed above. Applicants respectfully request that the rejection as to these claims be withdrawn.

By way of the Office Action mailed February 22, 2005, claims 4, 17, 18, 19, 20, 33 and 34 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to *Allen et al. (Allen)* in view of U.S. Patent Number 4,756,709 to *Stevens (Stevens)*. This rejection is respectfully traversed to the extent that it may apply to the presently presented claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2142, 2143.

Claims 4, 17, 18, 19, 20, 33 and 34, require that "the elastic inner layer includes a front piece, a back piece and a crotch piece, wherein the crotch piece is attached to the front piece and the back piece", as discussed above. Neither *Allen* nor *Stevens*, alone or in combination, teach or suggest a disposable absorbent garment having an elastic inner layer as claimed. Therefore, a *prima facie* case of obviousness has not been established because

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the prior art references do not teach or suggest all the claim limitations. Applicants respectfully request the rejection be withdrawn.

Additionally, there is no motivation to combine *Allen* and *Stevens*. The Examiner summarily states that "It would therefore be obvious to one of ordinary skill in the art at the time of the invention to construct the garment of *Allen* with a stretchable extensible outer layer as taught by *Stevens* to produce a diaper providing an improved fit to the wearer." (Office Action at page 3). However, the Examiner fails to cite to either *Allen* or *Stevens* showing this purported motivation to combine.

The references both mention fit, but that alone does NOT render the resultant modification or combination obvious unless the prior art teaches or suggest the desirability of the modification or combination. Since the references do NOT provide motivation to combine, the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

Not only is there no suggestion or motivation to combine, adding the outer cover of *Stevens* to the article of *Allen* would frustrate one of the purposes of *Allen*, i.e., to create a void space between the topsheet and the absorbent core. Therefore there would be no reasonable expectation of success as required by § 103.

*Allen* states that "ideally the longitudinally contracted and foreshortened topsheet 12' will generally conform to the wearer, while the larger radius of curvature of the absorbent core 18' allows the core 18' to fall away from the topsheet 12' and create the void space 28' thereinbetween." (col. 13: lines 1-6, emphasis added)

*Stevens* provides a resiliently stretchable outer cover to provide a "form-fitting, anatomically self-adjusting disposable diaper that conforms to the baby's shape." (col. 3: lines 48-52). If the outer cover of *Stevens* provides a conforming fit, one skilled in the art would not, therefore, be motivated to add the outer cover of *Stevens* to the article of *Allen*. Doing so would frustrate the object of *Allen*, i.e., to create a void space, because the

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resiliently stretchable outercover of *Stevens* would not allow the core 18', of *Allen*, to fall away from the topsheet 12' and create the void space 28'.

No *prima facie* case of obviousness has been established because there is no reasonable expectation of success. Applicants respectfully request this rejection be withdrawn.

By way of the Office Action mailed February 22, 2005, claims 6, 8, 22, 23, 36 and 38 stand rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 5,037,416 to Allen *et al.* (*Allen*) in view of U.S. Patent Number 5,817,086 to Kling *et al.* (*Kling*). This rejection is respectfully traversed to the extent that it may apply to the claims as filed.

Claims 6, 8, 22, 23, 36 and 38 require that "the elastic inner layer includes a front piece, a back piece and a crotch piece, wherein the crotch piece is attached to the front piece and the back piece", as discussed above. Neither *Allen* nor *Kling*, alone or in combination, teach or suggest a disposable absorbent garment having an elastic inner layer as claimed. Therefore, a *prima facie* case of obviousness has not been established because the prior art references do not teach or suggest all the claim limitations. Applicants respectfully request the rejection be withdrawn.

As to claims 6, 22 and 36 specifically, neither *Allen* nor *Kling*, alone or in combination, teach or suggest all the claim limitations set forth in Applicants' claim. The Examiner acknowledges that *Allen* fails to teach the use of liquid permeable outer layer as required by claims 6, 22 and 36. The Examiner looks to one component of the bottom layer laminate of *Kling* to find a liquid permeable outer layer.

Applicants respectfully disagree with this line of reasoning. The bottom layer 5 of *Kling* is liquid-impermeable. (col. 3: line 26). The bottom layer 5 can also consist of a laminate of thermoplastic layer and a fibers fabric. (col. 3: lines 63-65). First, there is no teaching as to whether the fiber fabric is actually liquid permeable. Second, even assuming

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that it is, a laminate of this nature is NOT liquid permeable regardless of whether one component of the laminate is liquid permeable. The Examiner has failed to make a *prima facie* case of obviousness with respect to claims 6, 22 and 36 because neither *Allen* nor *Kling*, alone or combination, teach all the claim limitations, namely, a liquid permeable outer layer. Applicants respectfully request that this rejection be withdrawn.

As to claims 8, 23 and 38 specifically, the Examiner acknowledges that *Allen* fails to teach the use of liquid impermeable inner layers. However, the Examiner asserts that it would have been obvious to construct the inner layer of *Allen* with a liquid impermeable material as taught by *Kling* to provide a dry skin-contacting surface to the wearer.

The Examiner has provided no citation to either *Allen* or *Kling* evidencing the motivation or suggestion to make the combination. This appears to be post hoc rationalization to justify the combination.

*Allen* specifically teaches away from combination by teaching that the topsheet is liquid pervious to permit liquids to readily penetrate through. (col. 6: lines 16-18). One skilled in the art would not find motivation in *Allen* to add the liquid impermeable inner layer of *Kling*.

*Kling* discusses a liquid-impermeable topsheet **in conjunction** with the specific embodiment illustrated in Figs. 5 and 6. In that embodiment, there is a large front opening 431 through which urine is to pass, thus allowing the topsheet to be liquid-impermeable. However, *Allen* specifically teaches that, "the size of the passageway 21' is a balance between the **minimum** size necessary to accommodate variations in the placement of the anus relative to the perineum and various cross-sections of solid fecal material, while minimizing undue skin contact with such waste materials." (col. 12: lines 33-38, emphasis added).

One skilled in the art would NOT be motivated to take the liquid-impermeable topsheet of *Kling*, designed for urine and made useable only by the large front opening, and

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construct the inner layer and opening of *Allen*, which tries to minimize the size of the opening and place it near the anus for fecal material.

The Examiner has not established a *prima facie* case of obviousness because there is no motivation to combine references. Applicants respectfully request that this rejection be withdrawn.

**By way of the Office Action mailed February 22, 2005, claims 1 – 46 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 51 of copending Application No. 10/750402.**

The present application and Application No. 10/750402 are pending. Allowable subject matter has not been indicated in either of these applications. Where a provisional rejection under the judicially created doctrine of obviousness type double patenting is made between two or more applications, M.P.E.P. § 804(I)(B) states that “if the ‘provisional’ double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the ‘provisional’ double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.” It is not evident which of the pending application (or claims thereof) will become allowable first. Therefore, any action by application with regard to the present rejection is premature.

For at least the reasons stated above, it is respectfully submitted that all of the presently presented claims are in form for allowance.

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Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc.  
deposit account number 11-0875.

The undersigned may be reached at: (920) 721-3016.

Respectfully submitted,

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